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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,808	12/13/1999	AVI J. ASHKENAZI	P0978-1C1	1650

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EXAMINER

ROMEO, DAVID S

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 09/11/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/459,808

Applicant(s)

ASHKENAZI, AVI J.

Examiner

David S Romeo

Art Unit

1647

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 01 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 01 August 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____


3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 80-87.Claim(s) objected to: 70-74, 76 and 79.Claim(s) rejected: 69, 75, 77 and 78.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


David S Romeo
Primary Examiner
Art Unit: 1647

Continuation of 3. Applicant's reply has overcome the following rejection(s): The rejection of claims 69-78 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,030,945.

Continuation of 5. does NOT place the application in condition for allowance because: Claims 69, 77, 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiley (25, cited by Applicants).

Claims 69, 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiley (25, cited by Applicants) as applied to claim 69 above, and further in view of Davis (e15).

Applicant argues that Wiley provides "an obvious to try" type of teaching, that there would be no reasonable expectation of success given the state of the art of cancer therapy, and that Davis does not teach a TRAIL protein for the treatment of blastoma. Applicant's arguments have been fully considered but they are not persuasive. Wiley teaches that that TRAIL polypeptides may be employed in treating cancer (column 18, full paragraph 1). Although Wiley is silent with respect to "blastoma", per se, a blastoma is a generic term for cancers. It is the specific teaching in Wiley regarding the treatment of cancer that provides the necessary teaching, suggestion, or motivation to treat a "blastoma." Wiley gives specific guidance as to the particular form of the claimed invention and how to achieve it. Applicant's argument that there would be no reasonable expectation of success given the state of the art of cancer therapy fails to comply with 37 CFR 1.111(b) because it amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. In response to applicant's arguments against the Davis reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Continuation of 10. Other: The terminal disclaimer filed on August 1, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,030,945 has been reviewed and is accepted. The terminal disclaimer has been recorded..